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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,745	11/07/2001	Vishwajith Kumbalimutt	213198	9685
45979	7590	06/26/2006	EXAMINER	
PERKINS COIE LLP/MSFT P. O. BOX 1247 SEATTLE, WA 98111-1247			LESNIEWSKI, VICTOR D	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/045,745	KUMBALIMUTT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Victor Lesniewski	2152	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 15-20 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 15-20 and 26-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. The amendment filed 4/6/2006 has been placed of record in the file.
2. Claims 1, 4-8, 15, 20, and 26-30 have been amended.
3. Claims 9-14, 21-23, 25, and 36 have been canceled.
4. Claims 1-8, 15-20, and 26-30 are now pending.
5. The applicant's arguments with respect to claims 1-8, 15-20, and 26-30 have been considered but are moot in view of the following new grounds of rejection.

***Continued Examination Under 37 CFR 1.114***

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. The applicant's submission filed on 4/6/2006 has been entered.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 2 and 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 2 and 15-20 recite descriptive material that may or may not be an embodiment of a computer system or embodied on a computer readable

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medium so as to be executable. Here, the “computer readable medium” does not constitute eligible subject matter for patentability. See MPEP 2106.IV.B.1.

9. The applicant’s specification defines a computer readable medium in terms of both statutory and non-statutory embodiments. See the specification, page 5, line 7 through page 6, line 12. The “communication media” embodiment is considered non-statutory as a signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101. A claim that can be read so broadly as to include statutory and non-statutory subject matter must be amended to limit the claim to a practical application.

### *Claim Rejections - 35 USC § 102*

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 2, 4, 8, 15-17, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Turner et al. (U.S. Patent Number 7,023,989), hereinafter referred to as Turner.

12. Turner has disclosed:

- <Claim 1>

A method for ensuring that a client computer on a computer network is properly configured for real-time communication, the method comprising: receiving, from the

client computer, a request to be notified when network conditions require a change in configuration settings of the client computer, wherein the configuration settings of the client computer allow the client computer to engage in real-time communication over the computer network (column 7, lines 50-58); monitoring the computer network to detect network conditions of network components other than the client computer that require a possible change in the configuration settings of the client computer (column 7, lines 59-63 and column 2, lines 47-57); and when a network condition that requires a change in the configuration settings of the client computer is detected, generating new configuration settings for transmission to the client computer without the need for the client computer to initiate the transmission; and transmitting the new configuration settings to the client computer so that the client computer can update its configuration settings with the new configuration settings to engage in real-time communication over the computer network with the detected network conditions and so that the new configuration settings are automatically transmitted to the client computer without the need for the client computer to initiate the transmission (column 7, line 64 through column 8, line 24; column 6, line 65 through column 7, line 27; and column 2, lines 47-57).

- <Claim 2>

A computer readable medium having stored thereon computer executable instructions for performing the method of claim 1 (column 7, lines 45-49).

- <Claim 4>

The method of claim 1, wherein monitoring the network includes monitoring a database comprising configuration settings for allowing computers on the computer network to conduct real-time communication (figure 2, item 40).

- <Claim 8>

The method of claim 1, wherein the client computer is currently configured for real-time communication according to a set of old configuration settings, and wherein the transmitting step comprises transmitting to the client computer changes that are to be made to the old configuration settings in order to derive the new configuration settings (column 6, lines 40-53).

- <Claim 15>

A system for facilitating real-time communication in a computer network, the system comprising: a client computer executing one or more programs for performing steps comprising engaging in real-time communication on the computer network (figure 1, item 12); at least one computer-readable medium having stored thereon a database, the database comprising configuration settings for allowing computers on the computer network to conduct real-time communication (figure 2, item 40); a server computer communicatively linked to the client computer, the computer-readable medium being accessible by the server computer (column 4, lines 60-65), the server computer executing one or more programs for performing steps comprising monitoring the computer network to detect network conditions of network components other than the client computer that require a possible change in the configuration settings of the client computer (column 7,

lines 59-63 and column 2, lines 47-57), when a network condition that requires a change in the configuration settings of the client computer is detected, generating new configuration settings for transmission to the client computer without the need for the client computer to initiate the transmission, and in response to the detecting step, transmitting the new configuration setting to the client computer over the computer network, so that the client computer can update its configuration settings with the new configuration settings to engage in real-time communication over the computer network with the detected network conditions and so that the new configuration settings are automatically transmitted to the client computer without the need for the client computer to initiate the transmission (column 7, line 64 through column 8, line 24; column 6, line 65 through column 7, line 27; and column 2, lines 47-57).

- <Claim 16>

The system of claim 15, wherein the database is part of a directory service having information as to the layout of the network, and wherein the configuration settings are based at least in part of the layout of the network (column 4, lines 24-29).

- <Claim 17>

The system of claim 15, wherein the one or more programs executing on the client computer perform further steps comprising transmitting a request for the latest version of the configuration settings to the server computer (column 4, lines 49-55).

- <Claim 30>

A system for configuring a computer for real-time communication on a computer network, the system comprising a means for generating, for transmission from a client

computer to a server computer, a request that the client computer be updated whenever network conditions require a change in configuration settings of the client computer, wherein the configuration settings of the client computer allow the client computer to engage in real-time communication over the computer network (column 7, lines 50-58); a means for monitoring conditions on the network to detect network conditions of network components other than the client computer that require a possible change in the configuration settings of the client computer (column 7, lines 59-63 and column 2, lines 47-57); a means for generating new configuration settings for transmission to the client computer without the need for the client computer to initiate the transmission when a network condition that requires a change in the configuration settings of the client computer is detected, and a means for generating for transmission from the server computer to the client computer, the new configuration settings as part of a protocol normally used by both the server computer and the client computer to structure real-time communication between the client computer and computers with which the client computer communicates so that the client computer can update its configuration settings with the new configuration settings to engage in real-time communication over the computer network with the detected network conditions and so that the new configuration settings are automatically transmitted to the client computer without the need for the client computer to initiate the transmission (column 7, line 64 through column 8, line 24; column 6, line 65 through column 7, line 27; and column 2, lines 47-57).

Since all the limitations of the invention as set forth in claims 1, 2, 4, 8, 15-17, and 30 were disclosed by Turner, claims 1, 2, 4, 8, 15-17, and 30 are rejected.



***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner.

15. Turner disclosed a method for allowing configuration settings for applications on remote servers to be automatically downloaded to network-enabled user interface devices so that the user may utilize the applications or various communications services.

16. Concerning claims 5 and 18, Turner did not explicitly state that the settings include the network address of the server. However, Turner does disclose that the network address of the server is maintained at the client device. See column 7, lines 53-56. It is clear that Turner's device manager must know the network address so that the device can communicate with the proper server and thus it would be a clear extension of Turner's system to include the network address of the server in the settings. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Turner by adding the ability for the settings to include the network address of the server. This satisfies the need for an arrangement that enables a telephony device to independently access any one of multiple servers within an IP network for respective subscriber services. See Turner, column 2, lines 22-25.

17. Thereby, Turner discloses:

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- <Claim 5>

The method of claim 1, wherein the configuration settings include the network address of the server computer that the client computer needs to contact in order to set up a real-time communication session (column 7, lines 53-56 and obviousness).

- <Claim 18>

The system of claim 15, wherein the configuration settings include the network address of a server that the one or more programs executing on the client should use to engage in real-time communication on the network (column 7, lines 53-56 and obviousness).

Since Turner discloses all of the above limitations, claims 5 and 18 are rejected.

18. Claims 6, 7, 19, 20, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner, as applied above, in view of Handley et al. (RFC 2543, SIP: Session Initiation Protocol), hereinafter referred to as Handley.

19. Turner disclosed a method for allowing configuration settings for applications on remote servers to be automatically downloaded to network-enabled user interface devices so that the user may utilize the applications or various communications services. In an analogous art, Handley disclosed a signaling protocol for creating, modifying, and terminating sessions such as Internet multimedia conferences and Internet telephone calls.

20. Concerning claims 6, 19, 20, and 28, Turner did not explicitly state generating messages concerning the configuration settings using a session initiation protocol. Turner's system does utilize SIP for communications between the client and servers, but there is no explicit discussion of the actual generation of messages with SIP. However, SIP was well known in the art at the

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time of the applicant's invention as evidenced by Handley who discusses in detail how messaging with the protocol works. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Turner by adding the ability to generate messages concerning the configuration settings using a session initiation protocol as provided by Handley. Here the combination satisfies the need for a more advanced protocol with session descriptions that allows clients to agree on a set of compatible media types. See Handley, page 1 of 105, last paragraph.

21. Thereby, the combination of Turner and Handley discloses:

- <Claim 6>

The method of claim 1, wherein the transmitting step comprises: inserting the new configuration settings into a message formatted according to a session initiation protocol (Turner, column 4, lines 19-24 and Handley); and transmitting the message to the client computer (Turner, column 7, lines 59-63).

- <Claim 7>

The method of claim 6, wherein the inserting step comprises inserting into the message a block of mark-up language text that includes the new configuration setting (Turner, column 5, lines 39-50).

- <Claim 19>

The system of claim 15, wherein the one or more programs executing on the server computer perform further steps comprising: generating a message formatted according to a session initiation protocol (Turner, column 4, lines 19-24 and Handley); and including the new configuration setting within the message, and wherein the transmitting step

comprises transmitting the message to the client computer (Turner, column 7, lines 59-63).

- <Claim 20>

The system of claim 15, wherein the one or more programs executing on the client computer perform further steps comprising generating a message formatted according to a session initiation protocol (Turner, column 4, lines 19-24 and Handley); inserting a request to obtain the new configuration setting into the message; and transmitting the message to the server computer (Turner, column 4, lines 49-55).

- <Claim 28>

The system of claim 30, further comprising: a server computer executing one or more programs performing steps comprising: communicating with the client computer according to a session initiation protocol (Turner, column 4, lines 19-24 and Handley); and transmitting to the client computer, the configuration document as part of a message formatted according to the session initiation protocol (Turner, column 7, lines 59-63).

Since the combination of Turner and Handley discloses all of the above limitations, claims 6, 7, 19, 20, and 28 are rejected.

22. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner, as applied above, in view of Rosenberg et al. (An XML Format for Presence Buddy Lists), hereinafter referred to as Buddy.

23. Turner disclosed a method for allowing configuration settings for applications on remote servers to be automatically downloaded to network-enabled user interface devices so that the

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user may utilize the applications or various communications services. In an analogous art, Buddy disclosed a useful format for tracking presence in a network using buddy lists.

24. Concerning claims 26 and 27, Turner did not explicitly state the use of permission lists that indicate the extent to which other users may monitor or contact an associated user.

However, buddy lists were well known in the art at the time of the applicant's invention as evidenced by Buddy. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Turner by adding the ability to use permission lists that indicate the extent to which other users may monitor or contact an associated user as provided by Buddy. Here the combination satisfies the need for a more flexible network where users can access their presence services from any machine. See Buddy, page 2 of 9, paragraph 3.

25. Thereby, the combination of Turner and Buddy discloses:

- <Claim 26>

The system of claim 30 wherein the new configuration settings include a configuration document that contains a list of users and an indication of the extent to which each of the users and groups of users is permitted to monitor the presence of the user of the client computer (Buddy).

- <Claim 27>

The system of claim 30, wherein the new configuration settings include a configuration document that contains a list of other users and groups of users and an indication of the extent to which each of the users and groups of users is permitted contact, via real time communication, the user of the client computer (Buddy).

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Since the combination of Turner and Buddy discloses all of the above limitations, claims 26 and 27 are rejected.

26. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in view of Handley, as applied above, further in view of Buddy.

27. The combination of Turner and Handley disclosed a method for allowing configuration settings for applications on remote servers to be automatically downloaded to network-enabled user interface devices so that the user may utilize the applications or various communications services. In an analogous art, Buddy disclosed a useful format for tracking presence in a network using buddy lists.

28. Concerning claim 29, the combination of Turner and Handley did not explicitly state the use of permission lists that indicate the extent to which other users may monitor or contact an associated user. However, Buddy clearly defines a buddy list that offers these features as discussed above in relation to claims 26 and 27. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Turner and Handley by adding the ability to use permission lists that indicate the extent to which other users may monitor or contact an associated user as provided by Buddy. Again the combination satisfies the need for a more flexible network where users can access their presence services from any machine. See Buddy, page 2 of 9, paragraph 3.

29. Thereby, the combination of Turner, Handley, and Buddy discloses:

- <Claim 29>

The system of claim 30, further comprising: a server computer executing one or more programs for performing steps comprising: receiving a first message from the client computer, the message including the identity of a user of the client computer (Turner, column 7, lines 50-58); retrieving information as to the extent to which individuals or groups of individuals are permitted to monitor the presence of the user on the computer network and to contact the user via real-time communication (Buddy); transmitting the information to the client computer in the form of mark-up language text as part of a second message formatted according to a session initiation protocol (Turner, column 5, lines 39-50, and Turner, column 4, lines 19-24 and Handley); wherein the one or more program executed by the client computer perform further steps comprising: transmitting the first message to the server computer in the form of a session initiation protocol message (Turner, column 4, lines 19-24 and Handley).

Since the combination of Turner, Handley, and Buddy discloses all of the above limitations, claim 29 is rejected.

30. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in view of Rosenberg et al. (SIP Extensions for Presence Authorization), hereinafter referred to as Presence.

31. Turner disclosed a method for allowing configuration settings for applications on remote servers to be automatically downloaded to network-enabled user interface devices so that the user may utilize the applications or various communications services. In an analogous art, Presence disclosed a SIP extension for authorizing a client's subscription in a network.

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32. Concerning claim 3, Turner did not explicitly state receiving a subscribe message formatted according to a session initiation protocol wherein the subscribe message includes a request for a user's profile. However, Presence defines SIP extensions for using subscribe messages and authorizing the user of the client computer. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Turner by adding the ability to receive a subscribe message formatted according to a session initiation protocol wherein the subscribe message includes a request for a user's profile as provided by Presence. Here the combination satisfies the need for the ability to determine whether or not a subscription request will be authorized in a network. See Presence, page 2 of 10, paragraph 1.

33. Thereby, the combination of Turner and Presence discloses:

- <Claim 3>

The method of claim 1 wherein the receiving step comprises: receiving a subscribe message formatted according to a session initiation protocol (Turner, column 2, lines 22-25; column 4, lines 19-24; and Presence, page 3 of 10, paragraph "When the...this specification."); wherein the subscribe message identifies the user that is operating the client computer and wherein the message includes a request for that user's profile and wherein the profile indicates how the computer should be conducting real-time communication over the network (Turner, column 7, lines 50-58; column 2, lines 47-57; and Presence, page 2 of 10, paragraph 4).

Since the combination of Turner and Presence discloses all of the above limitations, claim 3 is rejected.



*Conclusion*


34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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